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Filed : June 14, 2001

#### REMARKS

In the outstanding Office Action, the Examiner rejected Claims 1-3, 5-20, 22-26, 28-31, and 33-44. In addition, the Examiner objected to Claims 5, 6, 33, and 35 because of informalities. In response, Claims 5, 6, 33, and 35 have been amended. No new matter has been added. Thus, Claims 1-3, 5-20, 22-26, 28-31, and 33-44 are presented for further examination. The amendments to Claims 5, 6, 33, and 35 are merely to resolve informalities cited by the Examiner, and thus do not narrow the scope of protection. Reconsideration and allowance of all Claims 1-3, 5-20, 22-26, 28-31, and 33-44 in light of the present remarks is respectfully requested.

In the Office Action the Examiner stated that the Declarations filed under 37 C.F.R. § 1.131 are ineffective to overcome the Wong reference (U.S. 6,748,375). Specifically, the Examiner stated that the Declarations did not establish diligence during three time periods: September 6, 2000 to November 12, 2000, November 12, 2000 to November 27, 2000, and November 28, 2000 to December 1, 2000.

Applicant respectfully submits that at least one of the inventor and outside counsel worked diligently to produce the outcomes that were listed in the previous Declarations throughout the entire period from September 6, 2000 to December 1, 2000 including those time periods cited by the Examiner, September 6, 2000 to November 12, 2000, November 12, 2000 to November 27, 2000, and November 28, 2000 to December 1, 2000.

Specifically, Applicant submits that during the time period from September 6, 2000 to November 12, 2000, the following activities occurred. During the period from September 6, 2000 to September 29, 2000, Paul Thompson, inventor and Eric Nelson of Knobbe, Martens, Olson & Bear, LLP, Hitachi's outside patent counsel scheduled and prepared for an invention disclosure meeting. Applicant respectfully submits that during the period from September 6, 2000 to September 29, 2000 Paul Thompson and Eric Nelson, worked diligently to reduce the invention to practice during the normal course of their workload. On September 29, 2000 Paul Thompson and Eric Nelson were in the invention disclosure meeting. At that meeting Eric Nelson received instruction to perform a patentability search for the claimed invention. During the period from September 29, 2000 to October 18, 2000, Eric Nelson performed the patentability search and drafted a report of the search results. Applicant respectfully submits that

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during the entire period from September 29, 2000 to October 18, 2000 Eric Nelson, during the normal course of his workload worked diligently to reduce the invention to practice. During the period from October 18, 2000 to November 12, 2000 Paul Thompson reviewed the patentability search report, and prepared documentation to send to Eric Nelson for use in preparing a provisional application. Applicant respectfully submits that during the period from October 18, 2000 to November 12, 2000 Paul Thompson, worked diligently to reduce the invention to practice during the normal course of his workload. Accordingly, Applicant respectfully submits that during the period from September 6, 2000 to November 12, 2000 Paul Thompson and/or Eric Nelson, worked diligently to reduce the invention to practice during the normal course of their workload.

With respect to the time period from November 12, 2000 to November 27, 2000, Applicant submits that Eric Nelson developed and produced a draft of the provisional application for client review. Accordingly, Applicant respectfully submits that during the period from November 12, 2000 to November 27, 2000 Eric Nelson, during the normal course of his workload worked diligently to reduce the invention to practice.

With respect to the time period from November 28, 2000 to December 1, 2000, Applicant submits that Eric Nelson revised the draft according to comments from Paul Thompson and/or Joseph Smallwood in the November 27, 2000 conference. Accordingly, Applicant respectfully submits that during the period from November 28, 2000 to December 1, 2000 Eric Nelson, diligently to reduce the invention to practice during the normal course of his workload worked.

Accordingly, Applicant respectfully submits that during the entire period from September 6, 2000 to December 1, 2000 Paul Thompson and/or Eric Nelson, during the normal course of their workload worked diligently to reduce the invention to practice.

*Declarations* submitted herewith by Paul Thomson-inventor, and Eric Nelson-outside counsel, show that the claimed invention was conceived by Mr. Thomson on or before September 6, 2000 in this country. Furthermore, the *Declarations* shows that Mr. Thompson and Applicant's representatives were diligent in constructively reducing the invention to practice by preparing and filing the provisional application during the entire period from September 6, 2000 to December 1, 2000, i.e., the filing of U.S. Provisional Application No. 60/250,835, a priority

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application for the above-referenced application. These *Declarations* include statements that the inventor and/or representative attorneys were

In light of the above, Applicant submits that Wong is removed from use as a reference for claim limitations and this removal enables patentability, even as under § 103. The *Declarations* by Paul Thomson, Joseph Smallwood and Eric Nelson show possession of the whole invention by the inventors as claimed prior to the effective priority date of Wong, i.e. September 6, 2000, and that there was reasonable due diligence through the application filing date. Since the inventor has demonstrated inventorship prior to Wong's filing date, Wong should be removed as a reference for claim limitations. Accordingly, it is submitted that Claims cannot be held as unpatentable under § 103. Applicant respectfully requests the withdrawal of all claim rejections under § 103 and the prompt allowance of the claims.

Notwithstanding the above, Applicant respectfully submits that the claims, as amended, are patentable over the current art of record. It is well-settled that "a showing of a suggestion, teaching, or motivation to combine [or modify] the prior art references is an 'essential component of an obviousness holding'." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). The Examiner can satisfy the burden of showing obviousness of the combination or modification "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Applicant respectfully submits that there is no teaching or suggestion to select certain specific aspects of Chang and Wong and to selectively exclude others in order to derive the presently claimed invention. Chang discloses a system in which a user manipulates closed caption data and selects words for which a translation or a dictionary definition can be retrieved. The system of Chang is a self-contained electronic dictionary/translation device. The stand-alone device is independent of and separate from the television and has its own local database. See column 2, line 30 -3 through column 3, line 12. In contrast, Wong discloses a system which automatically searches closed caption data for key words and displays web site URL's related to

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the key words. To modify Chang with Wong would fundamentally change the stand-alone nature of the Chang device and its operation by generation of a network device. Likewise, to modify Wong with Chang would fundamentally change the automatic nature of the Wong system by generation of a user-input device. Accordingly, applicant respectfully submits that there is no teaching or suggestion of such modification in the prior art or in the problems solved by the Wong and Chang references.

Accordingly, Applicant respectfully submits that neither Chang nor Wong contemplate or suggest modification which would result in a system configured to transmit, via a network, selected symbols to a database system that is external to the display, where the selected symbols were selected as a result of receiving, via an input device, control instructions to select at least one of the symbols. Thus, Applicant respectfully submits that Claims 1-3, 5-20, 22-26, 28-31, and 33-44 are in condition for allowance.

#### CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns regarding the 1.131 petition as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes pursuant to statutory sections 102, and/or 103, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. In light of these amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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